

Applicants wish to thank Examiner Afremova for acknowledging that Claim 18 and 19 were entered by Preliminary Amendment filed on October 10, 2000, during a discussion with their undersigned Representative on May 30, 2002.

Applicants elect, with traverse, Group I, Claims 1-4 and 8-11, for further prosecution.

Applicants submit that the claims of Group III, V, and VII are directly dependent from the claims of Group II. In addition, the claims of Group IV and VI are directly dependent from the claims of Group I. Moreover, the claims of Group I depend directly from the claims of Group II. Accordingly, these Groups clearly have a technical relationship that involves the same special technical feature: the osteoclast precursor cell. For the Examiner's convenience, Applicants attach an Appendix to this Restriction Response showing the clear relationship between the Groups of the present invention.

The Examiner, citing PCT Rule 13.1 and 13.2, contends that Groups do not relate to a single general inventive concept because they lack the same or corresponding special technical features. Applicants wish to point out that MPEP 1893.03 (d) states that:

A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature.

Groups I-VII do share a common technical feature, the osteoclast precursor cell. Accordingly, the criteria for unity of invention are satisfied.

Also citing PCT Rule 13.1 and 13.2, the Examiner, contends that a lack of unity exists between Groups I-VII, because the special technical feature of the present invention - osteoclast precursor cell - does not define a contribution over the prior art. To support this assertion, the Office cites WO 96,07733 from the International Search Report. However, the Office's reliance on the International Search report is misplaced and Applicants point out that

the International Preliminary Examination Report (see English translation attached herewith) at paragraph 2, which states:

"The inventions described in claims 1 through 17 are not described in the documents cited in the ISR nor in the documents considered relevant to the inventions."

Applicants respectfully traverse the Restriction Requirement on the ground that unity of invention does exist between Groups I-VII because there is a technical relationship that involves the same special technical feature. It is this technical feature that defines the contribution which each of the Groups, taken as a whole, makes over the prior art.

Applicants traverse the Restriction Requirement on the additional grounds that the Office has not applied the same standard of unity of invention as the International Preliminary Examination Authority. The Authority did not take the position that unity of invention was lacking in the International application and examined all claims together (see the International Preliminary Examination Report appended herewith). Applicants note that PCT Article 27(1) states:

No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.

Moreover, Applicants respectfully traverse on the grounds that the Office has not shown that a burden exists in searching the entire application.

MPEP in §803 states as follows:

"If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."


Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office. In fact, the International Searching Authority has searched all of the claims together.

For the reasons set forth above, Applicants contend that the Restriction Requirement is improper and should be withdrawn. Withdrawal of the Restriction and Election of Species Requirement is respectfully requested.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

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